

REMARKS

Claims 2 through 7 and 9 through 11 are pending in this Application. Claims 1, 8 and 12 through 15 have been cancelled and claim 2 amended by incorporating the limitations of claims 1 and 8 therein. Applicants submit that the present Amendment does not generate any new matter issue or, indeed, any new issue. Accordingly, entry of the present Amendment and Remarks, and favorable consideration, are respectfully solicited pursuant to the provisions of 37 C.F.R. §1.116.

Claims 1 through 4 and 12 through 14 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Unger in view of DiGiovanni et al.

This rejection is traversed. Indeed, this rejection has been rendered moot by incorporating the limitations of claims 1 and 8 into claim 2, claim 8 not being subject to this rejection. Applicants would note that claims 1 and 12 through 14 have been cancelled.

Based upon the foregoing, Applicants submit that the imposed rejection of claims 1 through 4 and 12 through 14 under 35 U.S.C. § 103 for obviousness predicated upon Unger in view of DiGiovanni et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 5 through 11 and 15 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Unger in view of DiGiovanni et al.

In the statement of the rejection, the Examiner apparently relied upon the reasons offered in rejecting claim 1. Specifically, the Examiner **admitted** that Unger does not show a cladding region having a plurality of sub medium regions with a refractive index lower than that of the main medium and a hexagonal structure. The Examiner then referred to certain features of DiGiovanni et al. The obvious fact should be stated: **The Examiner never made any factual determinations**

to support the conclusion that one having ordinary skill in the art would have been realistically lead to combine the applied references in such a manner as to arrive at the claimed invention and explained why, as judicially required. *In re Lee*, 237 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002); *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 57 USPQ2d 1161 (Fed. Cir. 2000); *Ecolochem Inc. v. Southern California Edison, Co.*, 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000). The Examiner then concluded that one having ordinary skill in the art would have gone one step further and then modify whatever fiber would have been suggested by Unger and DiGiovanni et al. to further incorporate features from DiGiovanni et al. The reason offered is that "...because it has been held to be within the general skill of a worker in the art to select a known material and operating parameters on the basis of its suitability for the intended use." (ultimate sentence of the fourth enumerated section on page 3 of the August 8, 2003 Office Action). This rejection is traversed.

Initially, Applicants will treat this rejection as though applied against claim 2, because limitations of claims 1 and 8 have been incorporated therein. Applicants would stress that the Examiner has completely failed to provide a "thorough and searching" factual inquiry and failed to explain **why** one having ordinary skill in the art would somehow have been realistically impelled to engraft selected features from each of the applied references to arrive at the claimed invention. *In re Lee, supra*. The Examiner has improperly relied upon the above quoted generalization. Generalizations do not suffice. *Ruiz v. A.B. Chance Co., supra*; *Ecolochem Inc. v. Southern California Edison, Co., supra*. See, also, *In re Kotzab*, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999); *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998).

As articulated by the Court of Appeals for the Federal Circuit in *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 63 USPQ2d 1374, 1387 (Fed. Cir. 2002):

The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence.

The Examiner's generalization is inconsistent with prevailing jurisprudence requiring facts.

Applicants would further submit that even if the applied references are combined, the claimed invention would **not** result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). This is because the claimed invention embodies a novel feature which is neither disclosed nor suggested by the prior art. Specifically, it is quite novel that the fraction of optical power located in the sub medium is lower than one percent (or lower than 10^{-6} as disclosed at page 28 of the written description of the specification, lines 11-13 and in Fig. 15). This novel aspect enables efficient fabrication of an optical fiber having low optical loss and with highly repeatable characteristics, as disclosed at page 29 of the written description, lines 1-29. This is because the present invention utilizes the sub medium in order to reduce bending loss -- not to enlarge chromatic dispersion as in the prior art, such as DiGiovanni et al. The use of a sub medium to reduce bending loss is a novel feature which is neither disclosed nor suggested by DiGiovanni et al. Accordingly, even if the concepts of DiGiovanni et al. were somehow impressed into the fiber of Unger, the claimed invention would **not** result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, *supra*.


Based upon the foregoing, it should be apparent that a *prima facie* basis to deny patentability to the claimed invention has not been established for lack of the requisite factual basis and want of the requisite realistic motivation. Applicants, therefore, submit that the imposed rejection of claims 5 through 11 and 15 under 35 U.S.C. § 103 for obviousness predicated upon Unger in view of DiGiovanni et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing, it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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